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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,625	05/04/2001	R. Michael McGrady	D-1137	9504

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

CA

Office Action Summary	Application No. 09/849,625	Applicant(s) MCGRADY ET AL.	
	Examiner Steven B. McAllister	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 10-22 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species I in the reply filed on 4/14/2005 is acknowledged. The traversal is on the ground(s) enumerated in that reply. This is not found persuasive.

Regarding Applicant's argument that the requirement is not timely and that there is no burden, it is noted that this is the first examination of the case performed by the present examiner. Therefore, in order to exert due diligence in examining the case, the examiner cannot merely rest on the examination and search performed by the previous examiner. Since the examiner must search and fully consider the case, he faces substantially the same burden as if the case had never been acted upon.

Regarding Applicant's argument that the Species Requirement must show that the species are mutually exclusive, the examiner respectfully disagrees.

It is further noted that Applicant selected claims 1-10, and 15-25 as readable on Species I. It is noted claim 25 was grouped with the Species due an inadvertent and incorrect statement that claim 25 was generic in a previous Species Requirement. In the most recent requirement, however, that claim was withdrawn from the group of generic claims. The examiner regrets any confusion this may have caused.

Additionally, claims 10, and 15-22 are drawn to other species and are not readable on Species I.

Claims 10, 15-22 and 25 are hereby withdrawn, leaving claims 1-9, 23 and 24 which are examined below.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites that step (e) includes providing an input “indicative that the second quantity of the first type of medical item has been stocked at the remote storage location.” However, in claim 1 the data of step (e) is recited as “indicative of the use of a second quantity of the first type of medical item”. The use of the term “use” is unclear. It is not clear how the item is being used by sitting in a second storage location. It would appear that its use would occur when it is administered.

Note Regarding Examination

In the previous Office Action, the examiner stated that certain subject matter was common knowledge or old and well known. Per MPEP 2144.03(C), Applicant must adequately traverse the statements that something is old and well, or common knowledge in the subsequent response. It is noted that the traversals presented in the subsequent response are inadequate because “To adequately traverse such a finding, an applicant must specifically point out the

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supposed errors in the examiner's action, which would *include stating why the noticed fact is not considered to be common knowledge or well-known in the art.*" MPEP 2144.03(C). A statement indicating why the noticed fact is not considered to be common knowledge or old and well known was not included in the subsequent response. Since the traversal in the subsequent response was inadequate, as required by MPEP 2144.03(C), the common knowledge or well-known in the art statements are taken to be admitted prior. It is further noted that this statement is made regarding all common knowledge or old and well known statements made in the prior Office Action, including those relevant now only to claims which are withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 23 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by, or in the alternative under 35 U.S.C. 103(a) as being unpatentable over Lester et al (6,021,392) and Colella et al (6,003,006) incorporated by reference into Lester.

Lester et al disclose a method comprising storing a plurality of medical items in a plurality of storage locations within a pharmacy (see e.g., use of bar coded shelf labels as in Fig. 14 of Lester); storing data in a data store corresponding to the medical items (see e.g., col. 11, lines 1-12 of Lester); providing input indicative of taking a first quantity of a first type of medical item from a first storage location for use in second location outside of the pharmacy; and

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providing input indicative of the use of a second quantity of the items at the second location (see e.g., col. 4, lines 1-26 of Colella). Lester and Colella further show comparing amount removed to a second location and the amount used, since the automatically tracks inventory in order to provide for re-ordering of drugs, and in order to determine the amount of the drug within the hospital system (the pharmacy and DDM's) and in order to determine the amount in a DDM, the amount sent to the DDM and the used must be compared.

Alternatively, Lester and Colella teach all elements except comparing the amount removed to a second location and the amount used. However, it is notoriously old and well known in the art to compare the amount in and the amount out in order to prevent loss. It would have been obvious to one of ordinary skill in the art to modify the method of Lester/Colella by comparing the amount removed to a second location and the amount used in order to reduce loss and theft.

As to claim 23, the computer readable media operative to carry out the method steps is shown by Lester/Colella or in the alternative is obvious over Lester/Colella, as discussed above.

As to claims 2, 3, and 24, Lester/Colella show an output indicative of the difference between amount removed to a second location and the amount used comprising the amount of the drug in the DDM.

As to claim 4, Lester/Colella show all elements of the claim including indication the absence of data related to the first medical item since the system tracks and audits the drugs and such auditing of the tracked drugs reveals missing drugs and information.

As to claim 4, Lester/Colella show all elements of the claim except noting the absence of data related to the first type of medical item. However, it is notoriously old and well known in the art to provide an indication of missing data related to a tracked item. It would have been obvious to one of ordinary skill in the art to modify the method of Lester/Colella by indicating the missing information in order to flag missing or incorrectly logged items.

Claims 1, 5 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by, or in the alternative under 35 U.S.C. 103(a) as being unpatentable over Lester et al (6,021,392) and Colella et al (6,003,006) incorporated by reference into Lester.

As to claims 1 and 5, Lester et al disclose a method comprising storing a plurality of medical items in a plurality of storage locations within a pharmacy (see e.g., use of bar coded shelf labels as in Fig. 14 of Lester); storing data in a data store corresponding to the medical items (see e.g., col. 11, lines 1-12 of Lester); providing input indicative of taking a first quantity of a first type of medical item from a first storage location for use in second location outside of the pharmacy comprising for stocking a DDM; and providing input indicative of the use of a second quantity of the items at the second location comprising the amount stocked at the DDM. Lester and Colella further show comparing amount removed to a second location and the amount used (stocked at the second location), since the automatically tracks inventory and provides an audit trail in order to provide for re-ordering of drugs and provide the audit trail, the amount sent and the amount received must be compared.

Alternatively, Lester and Colella teach all elements except comparing the amount removed to a second location and the received at the second location (the amount used).

However, it is notoriously old and well known in the art to compare the amount in and the amount out in order to prevent loss. It would have been obvious to one of ordinary skill in the art to modify the method of Lester/Colella by comparing the amount removed to a second location and the amount used in order to reduce loss and theft.

As to claim 6, Lester/Colella show providing input through a device adjacent the remote storage location indicative of a third quantity taken for use by a patient and including that data in a data store.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lester/Colella.

As to claim 7, Lester/Colella show removing a fourth quantity of a first type of medical item from remote storage comprising expired drugs; providing at least one input indicative of the removal; and storing data indicative of the removal of a fourth quantity. Lester/Colella do not explicitly show that the expired drugs are removed to the pharmacy. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of Lester/Colella by removing the expired drugs to the pharmacy to account for them and dispose of them.

As to claim 8, Lester/Colella show comparing the first, second, third and fourth quantities, since it shows tracking the drugs and auditing the drugs, and in order to do so, the quantities must be compared in order account for the drugs.

As to claim 9, Lester/Colella show providing an output indicative of an unaccounted for portion, since it shows tracking and auditing the drugs and such auditing produces an indication of unaccounted for items.

Alternatively, as to claim 9, Lester/Collela show all elements except providing an output indicative of an unaccounted for items. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the method of Lester/Colella by producing an indication of unaccounted for drugs in order to reduce loss or theft.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

Steven B. McAllister
Primary Examiner
Art Unit 3627

STEVE B. MCALLISTER
PRIMARY EXAMINER